

REMARKS

I. Status and Disposition of the Claims

In the instant application, claims 1-3, 5-19, 21-35 and 37-60, of which claims 1, 17 and 33 are independent, are pending and under consideration on the merits.

II. Amendments to the Claims

In this Amendment and Response, Applicant resubmits the amendments submitted in the Amendment and Response filed December 1, 2008 and amends claims 1, 17 and 33 to recite elements of now-cancelled claims 2, 6, 18, 22, 34 and 38 respectively and to correct a grammatical error. In addition, Applicant updates the dependency of claims 3, 5, 7-14, 16, 19, 21, 23-30, 32, 35, 37, 39-45, 47, 50-51, 53, and 55-60. Moreover, Applicant amends claim 44 to correct a misspelling. Support for amendments to independent claims 1, 17, 33 and dependent claims 3, 5, 7-14, 16, 19, 21, 23-30, 32, 35, 37, 39-45, 47, 50-51, 53, and 55-60 can be found at, at least, page 6 of the Specification, "Various aspects of the methods and apparatus for practicing features of the invention may be one or more computer systems..." and page 6 of the Specification, "... which may accept a search query created and issued by a user via a graphical user interface." Moreover, the process of exporting is described in detail in Figure 3, and pages 15-16 of the Specification.

III. Response

In this Amendment and Response, Applicant respectfully repeats the same arguments disclosed in the Amendment and Response dated December 1, 2008. In addition, Applicant submits that none of the references cited in the Office Action¹ of September 29, 2008 teach or suggest the elements newly incorporated into claims 1, 17 and 33 from cancelled claims 6, 22 and 38. For example, amended claim 1 now recites, "selecting, from the folder, the preserved at least one resource and selecting an export destination, and exporting the selected preserved at least one resource to the export destination."

Cancelled claim 6 was rejected in the Office Action dated September 29, 2008 under 35 U.S.C. §103(a) as being unpatentable over US Pub. No. 2003/0046281, by Son (hereinafter "*Son*") and US Pub. No. 2002/0194195, by Fenton et al. (hereinafter "*Fenton*") and further in view of US Pat. No 5,222,234, by Wang (hereinafter "*Wang*"). Applicant submits that *Son*, *Fenton*, and *Wang* fail to teach or suggest the above-cited element.

The Office Action cites *Wang's* col. 2, lines 50-55 as teaching, "retriev[ing] documents." See Office Action dated September 29, 2008 at 4. Applicant disagrees with this assertion. *Wang's* col. 2, lines 50-55 refers to a document management system wherein "a plurality of end users 10 may store and retrieve documents in a shared library 12." In the Office Action of September 28, 2008, the Office Action appeared to analogize *Wang's* library with the system location or the folder. As

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

presented in the Amendment and Response submitted December 1, 2008, Applicant respectfully disagrees with the analogy. However, assuming *arguendo* that *Wang's* library is somehow analogous to the computer system location or the folder, *Wang's* "retriev[ing] [of] documents" is not the same as "selecting, from the folder, the preserved at least one resource and selecting an export destination, and exporting the selected preserved at least one resource to the export destination." Therefore, the cited reference fails to teach or suggest each and every element of cancelled claim 6, and therefore amended claim 1.

Moreover, one of ordinary skill in the art would not find it obvious to modify the apparatus of the combination of *Son* and *Fenton*, using the teachings of *Wang*, to achieve the required combination recited by amended claim 1. Applicant submits that while examiners may rely upon what is generally known in the art, they **must provide evidentiary proof** of that knowledge. See *In re Zurko*, 59 U.S.P.Q.2d 1693, 1697 (Fed. Cir. 2001) ("With respect to core factual findings in a determination of patentability . . . the Board cannot simply reach conclusions based on its own understanding or expertise . . . Rather, the Board **must point to some concrete evidence** in the record in support of these findings.") (emphasis is added).

Here, Applicant respectfully submits that the Office Action has not explained *why* or *how* one of ordinary skill would modify a hypothetical combination system of *Son* and *Fenton*, using the teachings of *Wang*, so as to arrive at the claimed invention. In particular, the Office Action has not explained at least: (a) *why* one of ordinary skill would modify steps of *Son* and/or *Fenton* so as to select, from the folder, the preserved at least one resource, select an export destination, and export the selected preserved at

least one resource to the export destination and, especially, (b) *how* one of ordinary skill would know to select and arrange steps of *Son*, *Fenton* and *Wang* so as to arrive at a system with the claimed features of "selecting, from the folder, the preserved at least one resource and selecting an export destination, and exporting the selected preserved at least one resource to the export destination," as recited in amended claim 1.

The burden is on the Patent Office to provide some tenable rationale as to *why* one of ordinary skill in the art would combine *Son*, *Fenton* and *Wang* so as to arrive at the presently claimed methods recited in the claims. In the present case, however, no such rationale has been provided.

For all of the §103 rejections except for that of claim 2, the Office Action merely asserts, "The combination of *Son*, *Fenton* and *Wang* discloses the elements of the claimed invention as noted above and, furthermore, discloses [the feature recited in the claim]." None of these assertions demonstrate *why* or *how* one would modify a hypothetical *Son/Fenton* combination with *Wang's* features so as to arrive at the claimed invention.

At best, the Office Action's assertion could be considered an assertion that the proposed modifications could be performed. However, "[t]he mere fact that a reference can be combined or modified does not render the resultant combination [or modification] obvious unless the results would have been predictable to one of ordinary skill in the art." M.P.E.P. § 2143.01 (emphasis in original). Combining *Son*, *Fenton* and *Wang* would not result in a predictable variation of Applicant's invention because a hypothetical *Son/Fenton/Wang* combination, which would lack a recited element, would not be a variation of Applicant's invention at all. *Son*, *Fenton* and *Wang* lack the

elements recited in amended claim 1, namely "selecting, from the folder, the preserved at least one resource and selecting an export destination, and exporting the selected preserved at least one resource to the export destination."

For at least these reasons, Applicant resubmits that the Office has not met the burden necessary to establish the obviousness of cancelled claim 6, and therefore, amended claim 1. Therefore the §103(a) rejection of claim 1 is improper, and should be withdrawn.

For at least the reason noted above, claims 17 and 33, which recite similar elements and were rejected under the same rationale, are also allowable under 35 U.S.C. 103(a). See Office Action at pages 3.

IV. Conclusion

In view of the foregoing remarks, Applicant submits that this claimed invention, as amended, is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicant therefore requests the entry of this Amendment and Response to Advisory Action, and the reexamination of the application, and the timely allowance of the pending claims.

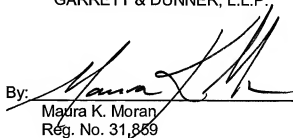
Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: January 12, 2009

By:



Madra K. Moran
Reg. No. 31,869